

REMARKS/ARGUMENTS

This amendment is in response to the final Office Action dated September 1, 2005. Claim 4 has been amended to correct a typographical error. No new matter has been added by this amendment. Therefore, claims 1-20 are again presented for the Examiner's consideration in view of the following remarks. A petition for a two-month extension of time is respectfully submitted herewith.

Reexamination and reconsideration of the above-identified application, pursuant to and consistent with 37 C.F.R. § 1.116, and in light of the amendments and remarks that follow, are respectfully requested. Because the present claims are believed to be in condition for allowance over the cited art, good cause exists for the entry of this amendment in accordance with 37 C.F.R. § 1.116.

As an initial matter, applicant would like to thank the Examiner for acknowledging the claim to foreign priority under 35 U.S.C. § 119.

Claim 4 was objected to because of an informality which has been remedied by changing the word "an" immediately before "DNS" to "a". Therefore, applicant respectfully requests that the objection to claim 4 be withdrawn.

Claims 1-3, 5, 7-12 and 14-20 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,694,133 ("*Tobita*") in view of U.S. Patent No. 6,370,394 ("*Anttila*"). Applicant respectfully traverses the rejection.

Applicants respectfully submit that *Tobita* and *Anttila*, taken alone or in combination, neither disclose nor suggest the inventions of independent claims 1, 9 and 14-20. Indeed, as will be demonstrated below, the Examiner's rejection should be withdrawn for two reasons: (1) the combination does

not result in the claimed invention; and (2) there is no motivation to combine the references to arrive at the invention.

As to the first requirement, the technical teachings of *Tobita* and *Antilla* are such that their combination would not result in the claimed invention.

The Examiner admits that *Tobita* does not teach a relay apparatus that is operable to convert a telephone number of a multi-function mobile telephone into an ID code unique to the multi-function mobile telephone. (See Office Action, pg. 3, numbered section 5.a.) As *Tobita* does not teach such a conversion, it is also not possible for *Tobita* to perform communication between the multi-function mobile telephone and the content providing apparatus through the relay apparatus based on the unique ID code.

In order to overcome *Tobita*'s deficiency, the Examiner relies on *Antilla*. According to the Office Action, "*Antilla* teaches wherein the telephone number is converted into an ID code." (Office Action, pg. 3, numbered section 5.a.)

The invention of *Antilla* "relates to a system and a method for establishing a telecommunication connection and transferring calls in a telecommunication network and a data transfer network. The invention further relates to a mobile station comprising connecting means for establishing a telecommunication connection and transferring information between the mobile station and said telecommunication network and data transfer network." (Col. 1, ll. 6-13.) Call routing

is facilitated by a database arranged in connection with the network server, in which database it is stored the identification information (e.g. a IP-address) defined for the telephone number of each mobile station according to the invention. The network server also answers for the protocol conversions, prior known to a person skilled in the art, from a circuit switched telephone network to e.g. a packet-switched

interconnecting network and vice versa. When a mobile station according to the invention is connected to a terminal device, an application program executed in the terminal device polls the identification (IP--address) of the "own" terminal device of mobile station stored in the mobile station and compares it with its own one. If the IP--addresses match, the terminal device knows that the connected terminal device is an "own" terminal device. In this case both incoming and established calls are transferred based upon the information contained in a database.

(Col. 4, ll. 28-44, emphasis added.)

Anttila goes on to state "Routing message 64 is transmitted preferably based upon IP-address 37 stored in the memory of the mobile station, but it would be equally possible to use another type of identification, such as the telephone number of mobile station 11, 12, 13." (Col. 11, ll. 27-31.) The identification information of *Anttila* may be "defined" for a telephone number; nonetheless, the Examiner does not assert, and *Antilla* is devoid of any teaching or suggestion, that the identification information such as the IP address is "an ID code unique to the multi-function mobile telephone" or "a unique code" that is obtained by converting a telephone number of the multi-function mobile telephone or terminal as required by independent claims 1, 9 or 14-20. Thus, *Anttila* cannot remedy the deficiencies of *Tobita*.

Even if one could import the teachings of *Anttila* into *Tobita*, which applicant does not believe is the case, the combination would not have each and every element required by independent claims 1, 9 and 14-20. As explained in the reply to the previous Office Action, according to *Tobita*, "gateway server 2 is constructed so as to, when a request comes in from the mobile phones 4, convert the intrinsic identifier which is provided to the request of the mobile phones 4 into a user ID corresponding to this intrinsic identifier by using the user ID

list table 70, and to transfer the request to the IP server 1." (Col. 9, line 66 to col. 10, line 4, emphasis added.) The "intrinsic identifier" of *Tobita* is clearly and simply not the same as the telephone number required by the independent claims of the instant application. In accordance with *Anttila*, an IP address or other identification information would be stored in a database. Importing the teachings of *Anttila* into *Tobita* would apparently result in the "intrinsic identifier" or corresponding "user ID" being replaced by identification information such as the IP address. However, this would appear to vitiate a key feature of *Tobita*, namely that "[t]he user ID is an identifier for specifying a user" who is a member of an image delivery service. (Col. 9, ll. 13-16.) Applicant respectfully submits that converting the telephone number of the multi-function mobile telephone or terminal cannot result in the IP address of *Anttila*. Also, there is no teaching or suggestion as to how *Tobita* could be redesigned to incorporate the elements of *Anttila*. Finally, it is not even clear that such a combination is feasible based upon the configuration and purpose of *Tobita's* image providing system.

As to the second requirement, for the Examiner to meet his burden under 35 U.S.C. § 103(a) to reject, for example, the independent claims, he must establish that one skilled in the art would be motivated to combine the teachings of *Tobita* and *Anttila*. Neither reference provides such motivation. As stated above, one would have to fundamentally alter the system and functionality of *Tobita* to incorporate *Anttila's* different components. The fact that a prior art process or device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). As stated in *In re*

Oetiker, 997 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992):

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

There is simply no teaching or motivation in the cited art to reengineer the *Tobita* system using the IP address of *Anttila* in order to arrive at the inventions of independent claims 1, 9 and 14-20. The Office Action cites to *Anttila* at column 3, lines 34-41 to supply a motivation, stating "It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the telephone number is converted into an ID code as taught by *Anttila* in the claimed invention of *Tobita* et al in order to provide an arrangement in which the same devices can be used as terminal devices in the telecommunication system equally well while connected to telecommunication networks realized using line connections." (Office Action, pg. 3, numbered section 5.a.) It is unclear how "line connections" have any bearing on either the claimed invention of the instant application or upon *Tobita*, and thus it does not appear that there is any motivation to combine the references in the manner suggested in an attempt to meet all of the limitations of the claimed invention.

Therefore, for at least these reasons, applicant respectfully requests that the rejection of independent claims 1, 9, and 14-20 be withdrawn. In addition, claims 2-3, 5 and 7-12 depend from independent claims 1 and 9, respectively, and include all the limitations thereof as well as other limitations neither disclosed nor suggested by the references of record. Thus, applicant submits that the subject dependent claims are also in condition for allowance.

Dependent claim 4 was rejected under 35 U.S.C. § 103(a) as being obvious over *Tobita* and *Anttila* in view of U.S. Published Application No. 2005/0021863 ("*Jungck*"). Dependent claim 6 was rejected under 35 U.S.C. § 103(a) as being obvious over *Tobita* and *Anttila* in view of U.S. Patent No. 6,148,253 ("*Taguchi*"). Dependent claim 13 was rejected under 35 U.S.C. § 103(a) as being obvious over *Tobita* and *Anttila* in view of U.S. Published Application No. 2001/0025275 ("*Tanaka*"). Claims 4, 6 and 13 depend from independent claims 1 and 9, respectively, and include all the limitations thereof as well as other limitations neither disclosed nor suggested by the references of record. Neither *Jungck*, *Taguchi* or *Tanaka* overcome the fundamental deficiencies of *Tobita* and *Anttila* noted above. Thus, applicant submits that dependent claims 4, 6 and 13 are also in condition for allowance.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have. If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: January 6, 2006

Respectfully submitted,

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